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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,698	04/15/2004	Stephen William Byng	7051P003	9170

23446 7590 07/07/2009

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EXAMINER	
KIM, ANDREW	

ART UNIT	PAPER NUMBER
3714	

MAIL DATE	DELIVERY MODE
07/07/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/825,698	BYNG, STEPHEN WILLIAM	
	Examiner	Art Unit	
	ANDREW KIM	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 4-12, and 14-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-12, and 14-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *15 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on 4/15/03. It is noted, however, that applicant has not filed a certified copy of the 2003907807 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The method and system claims consist of an abstract idea which is a judicial exception to 35 U.S.C. 101 (i.e., an abstract idea, natural phenomenon, or law of nature) and is not directed to a practical application of such judicial exception (e.g., because the claim does not require any physical transformation and the invention as claimed does not produce a useful, concrete, and tangible result). Specifically, the method needs to be tied to a particular apparatus such as a computer processor and a gaming machine in the body of the claim. A mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4-12, and 14-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (US 6,966,834) in view of Webb (US 6702673).

Claims 1, 12. Johnson discloses

selecting a value of a jackpot pool (4:36-47);

determining a range of random numbers as a function of the value of the jackpot pool (col. 5:45-58);

determining a number of winnable outcome values dependent on the residual credit (6:10-19);

Randomly generating an outcome from the range of random numbers (6:47-7:35); comparing the generated outcome with the winnable outcome values (6:10-19) awarding the prize if the generated outcome matches any of the winnable outcome values (6:10-19).

Johnson substantially discloses the invention as claimed but fails to explicitly teach determining a number of winnable outcome values dependent on the residual credit. Instead Johnson teaches winning a jackpot dependent upon the turnover of that EGD over a predetermined elapsed period of time. However, in an analogous reference, Webb teaches using fractional credits to receive full credits or promo awards (Abstract) to create a unique opportunity for casinos to gain market share in these environments by offering more favorable payoffs than the general market. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Johnson so that entries to the jackpot may be made through fractional credits to gain market share.

Claims 4, 5, 15, 16. Johnson discloses wherein the gaming machine uses a denomination, and the range of random numbers includes an upper limit, the method further comprising determining the upper limit by dividing the value of the jackpot pool by the denomination (col. 5:45-58).

Claims 4, 5, 15, 16. Johnson substantially discloses the invention as claimed but fails to explicitly teach wherein the number of outcome values of the player is equal to

the residual credit of the player divided by the denomination of the gaming machine. Instead, Johnson teaches a number range is defined and divided into two separate sections, the winning band and the losing band. However, it would have been obvious to one of ordinary skill in the art to have the number range set based upon the total number of entries or any other number to be compatible with a certain jackpot scheme to cater to the casino operators and increase casino profits. It would have been an obvious design choice because the invention would have substantially worked the same as Johnson's invention. Therefore, one of ordinary skill in the art would have seen the benefit of modifying Johnson with a jackpot win percentage that is determined by the residual credits and denominations to cater to the casino operators and increase casino profits.

Claims 6, 17. Johnson discloses wherein the jackpot pool is defined by an upper limit and comprises contributions of residual credit from a plurality of players, each player in the plurality of players playing on a separate gaming machine, such that the jackpot pool accumulates up to the upper limit of the jackpot pool (6:5-47, 7:24-67).

Claims 7, 18. Johnson discloses wherein the current value of the jackpot pool determines the number of winnable outcome values (6:5-47, 7:24-67).

Claims 8, 19. Johnson discloses assigning a unique identification code for each contribution of residual credit (tables 1-8).

Claims 9, 20. Johnson discloses the step of storing the unique identification code and the outcome values of each player in a storage means (6:41-7:30). The wagers made within the sliding windows are stored for awarding purposes.

Claims 10, 21. Johnson discloses the steps of generating more than one random outcome and comparing each generated outcome to the outcome values of each player (5:5-6:47).

Claim 11. Johnson discloses wherein the range of outcome values of a player is sequential in number (5:5-6:47).

Claim 14. Johnson discloses the step of determining an upper limit of the range of values from which an outcome is generated randomly (6:5-47).

Response to Arguments

Applicant's arguments filed 4/28/09 have been fully considered but they are not persuasive and are moot in view of the new grounds of rejection.

Regarding the 101 rejection, refer to *In re Bilski*.

Regarding the Johnson reference and that it does not anticipate amended claim 1, the Examiner respectfully requests why the Applicant considers the preamble as patentable weight.

Regarding the argument that the winning range is fixed, the Examiner respectfully asserts that the winning band is a percentage of the entire range and in conjunction with Webb, the modified invention can and would be used with residual credits.

Regarding the argument that Johnson's scaling factor is not function of the jackpot or prize value, the Examiner respectfully asserts that the scaling factor inherently associated with the value of the jackpot.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREW KIM whose telephone number is (571)272-1691. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dmitry Suhol/
Supervisory Patent Examiner, Art Unit 3714

7/6/2009 /A. K./
Examiner, Art Unit 3714